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| 09/957,449 | 09/21/2001 | Makoto Inoue | KYO004-US | 2508 |

21254 7590 02/08/2005
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| EXAMINER |
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JASMIN, LYNDIA C

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| ART UNIT | PAPER NUMBER |
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3627

DATE MAILED: 02/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/957,449

Applicant(s)

INOUE ET AL.

Examiner

Lynda Jasmin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 October 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 17-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 9/21/01.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Group 1 (claims 1-16) in the reply filed on October 21, 2004 is acknowledged.
2. Claims 17-30 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim.

Specification

3. The spacing of the lines of the specification is such as to make reading and entry of amendments difficult. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors.

Claim Objections

4. The claims are objected to because the lines are crowded too closely together, making reading and entry of amendments difficult. Substitute claims with lines one and one-half or double-spaced are required. See 37 CFR 1.52(b). Further, the claims appear to be a literal translation into English from a foreign document. Thus, Applicant's cooperation is requested in correcting any grammatical and idiomatic errors of which applicant may become aware in the claims.

Appropriate correction is required.

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5. Claims 1, 9, 12, 13, 15 and 16 are objected to because of the following informalities: the phrase corresponding to the abbreviated term "MD" should be written fully the first occurrence. Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are replete with errors. Some examples follow:

In claims 1-16 the recitations "an MD related master" and MD related information" render these claims indefinite since it is unclear what MD applicants are referring to.

Further, the phrase "or the like" (for example in claims 9, 14) renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "or the like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

Next the phrase "such as" (for example in claims 13, 16) renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

In claims 9-11, the claims are directed to neither a "process" nor a "machine," but rather embrace or overlap two different statutory classes of invention. It is therefore

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unclear whether Applicant is claiming a process or a machine. See MPEP §2173.05(p)

II or *Parte Lyell*, 17 USPQ2d 1548 (B.P.A.I., 1990).

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 9-11 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are directed to neither a "process" nor a "machine," but rather embrace or overlap two different statutory classes of invention. The claims begin by discussing a method, and the body of the claims discusses the specifics of a system. "A claim of this type is precluded by the express language of 35 U.S.C 101 which is drafted so as to set forth the statutory classes of invention in the alternative only." See MPEP §2173.05(p) II or *Parte Lyell*, 17 USPQ2d 1548 (B.P.A.I., 1990).

Double Patenting

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA

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1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 1-16 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of copending Application No. 09/933,119. Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications achieved the end same result of ordering item from various masters.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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12. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

13. Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over King, Jr. et al. (5,319,542), in view of Doyle et al. (5,694,551).

As best understood King discloses a system and method for ordering items comprising a database having a various kinds of masters, and a server which controls data communication with a plurality of terminals via a network and performs extracting or storing to the various kinds of masters in response to the terminal, wherein the database comprising: a merchandise master which stores information on items offered from dealers to customers by each item number unique to the item, and a merchandise assortment (MD) related master which stores a list of traded items among the items stored in the merchandise master agreed upon between the customer and dealer beforehand as the customer specific MD related information by each purchasing unit of the customer and by each dealer who offers the item to the customer, wherein the server comprising an item specific order controller for specifying, for each item, a dealer who offers each item in the ordering request, based on the MD related information of

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each purchasing unit, when it receive an ordering request for ordering one or more items from the terminal used by a user who belongs to the purchasing unit.

Further, the item specific ordering controller of King comprises an approval standard specific ordering control function for the case where the approval standard on ordering items is determined by the customer, when one or more items are selected by a user of the customer, and if the approval standards of the selected items and the items to be added newly are different, the function prompting ordering grouped by the same approval standard without accepting the addition of new items.

King further discloses automated form via electronic requisition process, however, fails to explicitly disclose a price form determining function and a deliverer for delivering item.

Doyle discloses the concept of channeling customer orders to various suppliers including accessing requisition form to place an order having requisition details, that includes information such as the item number, quantity order and customer price. Doyle further discloses a customer database that contains information regarding the customer authorization and delivery locations, e.g. "ship to" information.

From this teaching of Doyle, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the ordering system of King to include the price order form and the delivery of Doyle in order to facilitate invoice preparation and processing.

14. Applicants are reminded that functional recitation(s) using the word "for" (e.g. "for each unique item number", "each purchase dealer" etc. as recited in claims 1-16) have

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been considered but given less patentable weight because they fail to add any steps and are thereby regarded as intended use language. A recitation of the intended use of the claimed invention must result in additional steps. See *Bristol-Myers Squibb Co. v. Ben Venue Laboratories, Inc.*, 246 F.3d 1368, 1375-76, 58 USPQ2d 1508, 1513 (Fed. Cir. 2001) (Where the language in a method and system claim states only a purpose and intended result, the expression does not result in a manipulative difference in the steps of the claim.). If Applicant(s) desire to give the phrase greater patentable weight, the Examiner respectfully recommends Applicant(s) remove "for". Like always, such modification(s) must not constitute new matter and be supported in Applicant(s)' specification.

Conclusion

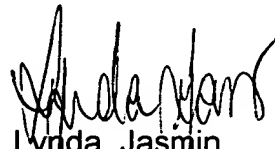
15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Gardner et al., Alloul et al., Reisman, and Pool et al. are cited for disclosing electronic ordering.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lynda Jasmin whose telephone number is (703) 305-0465. The examiner can normally be reached on Monday- Friday (8:00-5:30) alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert P Olszewski can be reached on (703) 308-5183. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

 2/6/05
Lynda Jasmin
Primary Examiner
Art Unit 3627

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